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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,612	06/28/2000	Bruce D. Lucas	6169-142	5855
40987	7590	06/15/2004	EXAMINER	
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			HUYNH, CONG LAC T	
			ART UNIT	PAPER NUMBER
			2178	7

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/605,612

Applicant(s)

LUCAS ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: response and the declaration under 37 C.F.R. 1.131 to the application filed on 6/28/00.
2. Claims 1-27 are pending in the case. Claims 19-21 have been withdrawn from consideration. Claims 1, 6, 10, 15, 19, 22, 25 are independent claims.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-18, 22-27 remain rejected under 35 U.S.C. 102(e) as being anticipated by Wesemann et al. (US Pat No. 6,349,132 B1, 2/19/02, filed 12/16/99).

Regarding independent claim 1, Wesemann discloses:

- retrieving a network-based document formatted for in the Visual Browser (figures 3-5; col 3, line 33 to col 4, line 6)
- identifying in the retrieved document a reference to the Voice Browser, said reference specifying electronic content formatted for audible presentation in the Voice Browser (figures 3-4; col 5, lines 12-38)

- transmitting said reference to the Voice Browser (figure 3: transmitting HTML documents in the HTML source #310 to the Voice Browser #340; col 5, lines 27-38: the system identifies the links in a document and provides users with an audio representation of the document text)
- the Voice Browser retrieving said specific electronic content and audibly presenting said electronic content in the Voice Browser (figures 3-5: the document is retrieved and played audio of text after the text to speech translating; col 5, lines 27-38)
- the Visual Browser visually presenting said network-based document concurrently with said audible presentation (col 6, lines 18-36: "Voice Browser #340 could be used in conjunction with Visual Browser #320 to provide simultaneously visual and audio interfaces..."; col 2, lines 20-37)

Regarding claim 2, which is dependent on claim 1, Wesemann discloses that the network-based document formatted for visual presentation in the Visual Browser is an HTML formatted document and the Visual Browser is a Web Browser (figure 3: the network document is a HTML document on the Internet so the visual browser #320 is a Web Browser; col 2, lines 20-52).

Regarding claim 3, which is dependent on claim 1, Wesemann discloses that said electronic content formatted for audible presentation in the Voice Browser is VoiceXML formatted electronic content (col 5, lines 20-53).

Regarding claim 4, which is dependent on claim 2, Wesemann discloses that said reference is a coordination markup attribute (col 2, lines 20-30 and col 8, lines 24-36: elements in the tags of a markup document include a markup attribute).

Regarding claim 5, which is dependent on claim 1, Wesemann discloses that said reference specifies a network-based document containing said electronic document formatted for audible presentation in the Voice Browser (col 5, lines 27-38) whereby the Voice Browser can retrieve said specified network-based document through the computer communications network and audibly present said electronic content contained in said specified network-based document, while the Visual Browser can visually present said network-based document formatted for visual presentation (col 6, lines 18-36; col 2, lines 33-37).

Regarding independent claim 6 and its dependent claims 7-9, the claims are merely the opposite way to retrieve and present a network-based electronic document. Wesemann discloses accessing network-based electronic content in both a Voice Browser and a Visual Browser where the web document is *displayed and presented simultaneously in the Voice Browser and the Visual Browser*. Wiseman, therefore, inherently discloses the both ways of presentation a web document in an audio interface and a visual interface (col 3, line 33 to col 4, line 6).

Claims 10-14 are for a machine readable storage of method claims 1-5, and are rejected under the same rationale.

Claims 15-18 are for a machine readable storage of method claims 6-9, and are rejected under the same rationale.

Regarding independent claim 22, Wesemann discloses:

- incorporating visual content in a network-based document (figures 7-8; col 2, lines 38-52; col 3, lines 33-47)
- formatting said network-based document for visual presentation in a Visual Browser (col 3, lines 23-47)
- inserting at least one markup tag in said network-based document, said markup tag containing a coordination markup attribute specifying a network-based document formatted for audible presentation in a Voice Browser (col 2, lines 20-30, col 8, line 24-36 and col 5, lines 11-37: the fact that a markup tag in the HTML codes of a web document can be used to identify a category in the web document presentation where the text document can be played in the audio interface indicates that a markup tag can be inserted to the HTML codes for specifying the audio presentation of the web document)
- whereby the Visual Browser when rendering said network-based document formatted for visual display can identify said coordination markup attribute in said markup tag and can transmit a reference to said specified network-based

document and audibly present said specified network-based document concurrently with the visual presentation of said network-based document formatted for visual presentation in the Visual Browser (col 3, line 48 to col 4, line 6 and col 6, lines 18-36)

Regarding claim 23, which is dependent on claim 22, Wesemann discloses that said network-based document formatted for visual presentation in a Visual Browser is an HTML formatted document and said Visual Browser is a Web Browser (figure 3: the network document is a HTML document on the Internet so the visual browser #320 is a Web Browser; col 2, lines 20-52).

Regarding claim 24, which is dependent on claim 22, Wesemann discloses that said network-based document formatted for audible presentation in a Voice Browser is a VoiceXML formatted document and said Voice Browser is a VoiceXML Browser (col 2, lines 20-53, figures 1, 3, col 6, lines 18-36).

Regarding independent claim 25, Wesemann discloses:

- incorporating voice content in a network-based document (col 5, lines 11-38)
- formatting said network-based document for audible presentation in a Voice Browser (col 6, lines 18-63)
- inserting at least one markup tag in said network-based document, said markup tag containing a coordination markup attribute specifying a network-based

document formatted for visual presentation in a Visual Browser (col 7, lines 10-53 and figures 6-9: the displayed web document as seen is encoded by the markup tags containing the markup attribute for a visual presentation of the web document; col 8, lines 23-36)

- whereby the Voice Browser when rendering said network-based document formatted for audible display can identify said coordination markup attribute in said markup tag and can transmit a reference to said specified network-based document and visually present said specified network-based document concurrently with the audible presentation of said network-based document formatted for audible presentation in the Voice Browser (col 10, lines 21-63; figures 5, 11; col 6, lines 18-36)

Regarding claim 26, which is dependent on claim 25, Wesemann discloses that said network-based document formatted for visual presentation in a Visual Browser is an HTML formatted document and said Visual Browser is a Web Browser (figure 3: the network document is a HTML document on the Internet so the visual browser #320 is a Web Browser; col 2, lines 20-52).

Regarding claim 27, which is dependent on claim 25, Wesemann discloses that said network-based document formatted for audible presentation in a Voice Browser is a VoiceXML formatted document and said Voice Browser is a VoiceXML Browser (col 2, lines 20-53 and col 10, lines 21-63).



***Response to Amendment***

5. The declaration filed on 4/1/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Wesemann reference (6,349,132).

The declaration does not support the claimed limitations. An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Wesemann reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). There is no evidence of facts with actual dates referred in the declaration. The date of the attached IBM Confidential Invention Disclosure BOC8 - 1999 - 0113 is not provided in the declaration. Merely stating that "my co-inventor and I conceived of the present invention at least as early as November 11, 1999" is not enough to establish the concept of the invention. The diligence, therefore, need not be considered. See MPEP 715.07(a).

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Wesemann reference to either a constructive reduction to practice or an actual reduction to practice. Applicants must show how the

evidence supports the diligence from prior the effective date of the reference to the filing date of the application. Statement as “exercised due diligence from prior to November 11, 1999 through June 28, 2000, the filing date for the above-identified patent application” is merely a general statement. The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”). See MPEP 715.07.

It appears to the Examiner that the Exhibit may be sufficient to prove conception of the invention if accompanied with a proper declaration. In the interest of compact prosecution, the Examiner points out that there is no evidence of diligence contained in the declaration.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McKenty et al. (US Pat No. 6,088,675, 7/11/00, filed 3/23/99, priority 10/22/97).

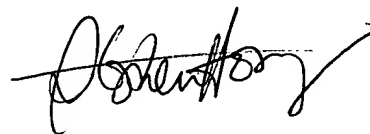
Haskell et al. (US Pat No. 6,654,931 B1, 11/25/03, filed 1/25/99, priority 1/27/98).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Clh  
6/4/04



**STEPHEN S. HONG**  
**PRIMARY EXAMINER**